



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO. 09348850	FILING DATE/99	BROWN FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. 104.301
-----------------------------	----------------	----------------------------	--------------------------------

JOHN R LEY LLC  
5299 DTC BOULEVARD  
SUITE 610  
ENGLEWOOD CO 80111-3327

IM22/0402

EXAMINER TENTONI, L
------------------------

ART UNIT 1732	PAPER NUMBER 3
------------------	-------------------

DATE MAILED: 04/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/348850

Applicant(s)

BROWN et al

Examiner

LEO B. TENTONI

Group Art Unit

1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-29 is/are pending in the application.  
Of the above claim(s) 1-16 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 17-29 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No. 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1732

### **DETAILED ACTION**

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1732, Examiner Leo Tentoni.

#### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a carving kit, classified in class 30, subclass 324.
- II. Claims 17-29, drawn to a carving process, classified in class 264, subclass 155.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another and materially different apparatus such as an apparatus including electrically or pneumatically operated means for striking a cutting die element. The apparatus as claimed can be used to practice another and materially different process such as a process of removing flash (i.e., excess molding material) from a molded thermoplastic product.

Art Unit: 1732

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with John Ley, applicant's representative, on March 26, 2001 a provisional election was made with traverse to prosecute the invention of Group II, claims 17-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Specification*

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. The following title is suggested: PROCESS OF CARVING SHAPES IN A PUMPKIN SHELL.

Art Unit: 1732

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no antecedent basis for carving shapes in the shell of fruits or vegetables (only pumpkins) as set forth in independent claims 17, 23 and 28.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 17-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 17, 23 and 28, "fruit or vegetable" renders the claims indefinite principally because it is not clear what applicant intends to cover by such a recitation (i.e., it is not clear what other fruits and/or vegetables is/are encompassed by these claims; note that the specification presently provides antecedent basis only for pumpkins).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1732

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nauman (U.S. Patent 4,296,659).

Nauman (col. 2, line 11 to col. 6, line 15) teaches a process of carving shapes in the shell of a pumpkin as set forth in the instant claims. The hammer/block of wood system of Nauman constitutes a striking tool within the meaning of the instant claims and thus, Nauman anticipates this claimed aspect.

#### *Allowable Subject Matter*

14. Claims 17-22, 28 and 29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

15. Claims 26 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo Tentoni whose telephone number is (703) 308-3834. The examiner can normally be reached on Monday - Friday from 6:30 A.M. to 3:00 P.M.

Art Unit: 1732

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Leo Tentoni

March 30, 2001

LEO B. TENTONI  
PRIMARY EXAMINER  
ART UNIT 1732